



Docket No.: 50090-370

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TC 2800 MAIL ROOM

5-23-2
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE 2002

In re Application of

:

Katsunobu Hori, et al.

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Serial No.: 09/756,846

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Group Art Unit: 2811

Filed: January 10, 2001

:

Examiner: H. Vu

For: SEMICONDUCTOR DEVICE HAVING A LAYERED WIRING STRUCTURE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Sir:

Noting the Office Action of March 13, 2002 wherein restriction has been required, Applicant(s) hereby elect, with traverse, Group relating to Figures 1A-1F (claims 1-5) for prosecution in the above-identified application.

In the Office Action dated March 13, 2002, the Examiner required election of one of the following species:

1. Embodiment 1 of Figures 1A-1F.
2. Embodiment 2 of Figures 2A-2C.
3. Embodiment 3 of Figures 3A-3D.
4. Embodiment 4 of Figures 4A-5D.
5. Embodiment 5 of Figures 6A-6G.
6. Embodiment 6 of Figures 7A-7G.

Under 35 U.S.C. § 121 and 37 C.F.R. § 1.142, an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP §§ 802.01, 806.04, 808.01) or distinct as claimed (see MPEP §§ 806.05 - 806.05(i)), and
- (B) There must be a serious burden on the examiner (see MPEP §§ 803.02, 806.04(a)-806.04(i), 808.01(a), and 808.02).

To properly support a restriction requirement, the Examiner must provide reasons and/or examples to support conclusions (see, e.g., MPEP § 803). The Examiner has not provided any reasons why the different embodiments are independent (i.e., there is no disclosed relationship between the embodiments which are unconnected in design, operation, or effect) or distinct (e.g., each embodiment is capable of separate manufacture, use, or sale, AND are patentable over each other).

Therefore, the Examiner has failed to establish a *prima facie* case of independence or distinctness under element (A), above, and the restriction requirement is improper for at least this reason.

Further, to establish a *prima facie* case of a serious burden on the Examiner sufficient to warrant a restriction, the Examiner must show by appropriate explanation either separate classification, separate status in the art, or a different field of search, that such a burden exists. The Examiner's Restriction Requirement is devoid of any showing of a serious burden on the Examiner, the Examiner has not met the required burden of (B) above, and the restriction requirement is therefore improper.

Therefore, the Examiner has failed to establish a *prima facie* case of a serious burden under element (B), above, and the restriction requirement is therefore improper for at least this reason.

Still further, in accord with MPEP § 803, even if the application includes claims to independent or distinct inventions, "the examiner must examine [the application] on the merits" if the search and examination of the application can be made without serious burden. As noted above, the Examiner has failed to provide a single reason why the examination of the entire application would pose a serious burden on the Examiner.

Therefore, for each of the above reasons, the Examiner's Restriction Requirement is legally erroneous and is improper. The Examiner is respectfully requested to withdraw the Restriction Requirement and consider the application in its entirety.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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